

### **III. REMARKS**

#### **Status of the Claims**

Claims 1, 4-6 and 8 are amended and claims 9 and 10 are added. Claims 1-10 are presented for further consideration.

#### **Summary of the Office Action**

Claims 12, stand rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, G.B. Patent No. 2,294,844 in view of the disclosure of Bridges, et al, U.S. Patent No. 6,546,246 and further in view of the reference Suzuki, U.S. Patent No. 6,493,540. Claims 3 and 4 stand rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, in view of the disclosures of Bridges and Suzuki, and in further view of the reference Henry, Jr. et al, U.S. Patent No. 5,603,084. Claims 5 and 6 stand rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, in view of the disclosures of Bridges, Suzuki and Henry, and further in view of Retzer,et al, U.S. Patent No. 6,009,325. Claim 7 stands rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, in view of the disclosures of Bridges, and Suzuki, and in further view of the reference Retzer,et al. Claim 8 is rejected under 35USC103(a) based on the combined disclosures of van den Huevel in view of Bridges. The Examiner is respectfully requested to reconsider his rejection in view of the following remarks.

Applicant has amended claims 4,5, and 6 to correct the inconsistencies in terminology. Specifically the word "characteristics" is replaced by the word "capabilities" as used in claim 1. The lack of antecedent basis raised by the Examiner

is therefore fully met.

### The Invention

According to independent claims 1 and 8, as amended, this invention involves a mobile station, having software radio architecture of the type that provides the capability of global usage, and includes a system for selecting among the modes, features and services available in the mobile station and supported within a particular cellular network of the globally available cellular communications networks. The processors of the mobile station store information relating to the capabilities of the mobile station and compile information relative to the capabilities of a cellular network in which it seeks services. A matrix of available modes, functions and services is compiled from which an array of such modes, functions and services is selected according to predetermined criteria. None of the cited references either alone or in combination disclose or teach such a mobile station system.

### Discussion of the Cited References

The examiner has again cited the reference van den Heuvel, et al as its primary support for the rejection of all of the claims on the basis of obviousness. As previously indicated, this reference teaches a system for providing a selection process for a subscriber to allow the use by a subscriber of certain features available in multiple communications systems 11-17 coupled together by a common wireline system 18. It requires an initial contact with a common system 19 to receive information on available networks and their features. The subscriber may select a desired network and feature, download the required software, and then contact the selected network. This does not described a system that is global in scope, but only local. There is no

capability for performing the functions from data stored on the mobile phone, but it is totally reliant on the service of the common system.

Accordingly, there are two intermediate entities required in the system of van den Heuvel, that are not required in the system of this invention, namely, wireline system 18, and a common communication system 19. The system of van den Heuvel is, therefore, limited in its application and cannot provide the globally adaptive function of the subject invention.

The rejection under 35USC103(a) combines the teaching of Van den Heuvel in combination with the reference Bridges. The reference Bridges involves a system by which a mobile station, in roaming mode, may access another wireless network that has a preferred status by virtue of a prearrangement with the home provider. This is described in the reference Bridges, beginning at column 8, line 51 through column 9, line 1, as follows:

"The present invention relates to a mobile station with intelligent roaming and/or over-the-air programming features. The present invention permits a mobile station to immediately obtain service on a preferred cellular, PCS or other wireless network system meeting a subscriber's service requirements. The selection or designation of such a system carrier may be configured to comply with, for example, preferences of a corporation having a National Account with the home wireless carrier, when there are multiple bands available.

According to an aspect of the present invention, a Preferred System Identification List (PSL) (for cellular systems) and/or an Intelligent Roaming Database Downloading (IRDB) (for cellular, PCS and other wireless systems) is stored within a memory or storage device of the mobile station. When the mobile station is roaming, the PSL or IRDB is accessed to indicate the band where the mobile station will find a preferred system."

The system requires a list of preferred service providers, it does not contemplate service access throughout globally dispersed cellular networks. In addition, there is no indication of how or why the teaching of Bridges could be combined with the system of van den Huevel. There is no processing of data received from a cellular system that is compiled with operational data of a mobile phone to form a matrix from which an operational structure can be formed according to predetermined criteria.

Also in support of the rejection of claim 1 based on obviousness, the Examiner has further combined the teachings of van den Huevel and Bridges with that of the reference Suzuki. The system of the reference Suzuki is described in the Summary of the Invention, as follows:

"According to an aspect of the present invention, there is provided in a mobile radio communication system in which each of a plurality of mobile stations and a base station randomly transmits and receives data to and from each other, a radio random access control system in which each mobile station receives all data from the base station, executes an analysis of destination mobile stations of the received data, obtains from the analysis result the number of mobile stations currently transmitting or receiving the data to or from the base station in a radio zone, in which the own station is present, and calculates delay time after a transmission timing collision at the time of the start of transmission of the own mobile station till the next start of transmission according to the obtained number of mobile stations excluding the own station."

Applicant submits that the teaching of this reference is far afield of the system of this invention and adds nothing to the teachings of van den Huevel and Bridges, except that information may be exchanged between a mobile telephone and a base station. The information received is used in the timing of transmissions. The combination of the references to obtain the subject invention

as described in claims 1 and 8 would not be obvious to one skilled in the art.

Since the combination of references cited, relating to independent claims 1 and 8, fail to support prima facie obviousness, the rejections of the dependent claims also fail. The teachings of the cited references Henry and Retzer, fail to remedy the deficiencies of the combined teaching of van den Huevel, Bridges, and Suzuki.

#### **The Issue of Obviousness**

According to basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the references must be viewed without the benefit of hindsight. (See MPEP sections 706.02(a) and 2141. Applicant submits that, the modification of the teachings of van den Heuvel, Bridges, and Suzuki with respect to claim 1 or the teachings of van den Huevel and Bridges with respect to claim 8, in order to obtain the invention, as described in the amended claims, would not have been obvious to one skilled in the art. There is no motivation in the cited references to make such a modification.

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must

teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, the combined teachings, do not disclose or suggest each feature of Applicants' invention as claimed. In particular there is no teaching in any of the references either alone or in combination, of the features defined in claim 1 as follows:

"a first processor for compiling and storing network characteristic data relating to said globally dispersed cellular communication networks, received over said common system parameter channel, relating to operational capabilities of said cellular networks;

a second processor for compiling and storing subscriber identification data relating to operational capabilities of said mobile station;

a third processor for combining said network characteristic data and said subscriber identification data into an addressable matrix of operational capabilities; wherein said third processor further generates an operational configuration based on said matrix and predetermined criteria."

Equivalent language appears in claim 8.

Applicant further submits, that, it does not appear that the Examiner has considered the claims as a whole, but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction

to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

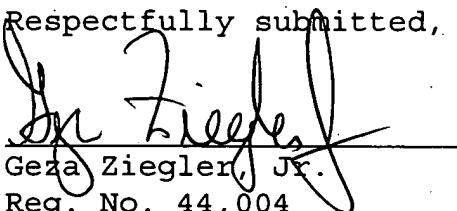
The above arguments apply equally to the rejected dependent claims as the further combined disclosures of Henry and Retzer, do not remedy the above described deficiencies.

**SUMMARY**

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$1,020.00 is enclosed for a three month extension of time. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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12 JANUARY 2005  
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